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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,265	10/06/2003	Koue Ohkawa	OHKAWA2	3445

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EXAMINER

THEXTON, MATTHEW

ART UNIT PAPER NUMBER

1714

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/678,265		OHKAWA ET AL.	
	Examiner		Art Unit	
	Matthew A. Thexton		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,12,14,16 and 18 is/are rejected.
- 7) ☒ Claim(s) 3,7,9,11,13 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>one sheet</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The IDS filed 2003 October 6 has been considered.

Specification

The title is objected to. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words, and may not contain more than 500 characters.

The abstract of the disclosure is objected to because: (1) the word "remainder" is misspelled, and (2) the use of "(pure water)" is misdescriptive because it does not accurately reflect the description and claims. Correction is required. See MPEP § 608.01(b).

Appropriate correction is required.

Drawings

The drawings are accepted.

Claims Version

The listing of claims submitted in the original submission has been examined.

Claims Analysis

Claim 1 is directed to lubricant mixtures comprising:

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- water; and
- 0.5 – 30 weight % of a mix of:
 - sucrose; and
 - 0.2 – 20 weight % based on the sucrose of a disaccharide caramel.

Claims 2-16 depend from claim 1 directly or indirectly and further specify or limit the: type of sucrose; presence and amount of sodium and/or potassium laurate; presence and amount of potassium sorbate; presence and amount of benzotriazole or its alkali metal salt.

The term disaccharide caramel is understood to mean burnt sugar as described in the prior art and is distinguished from candy caramel (sugar, butter, cream or milk, and flavoring) and from caramels formed by Maillard reaction (sugar and amino acids). Thus excluded are brown sugar and maple sugar and maple syrup. Disaccharide caramel is the colored product resulting from the heating of disaccharide (e.g., sucrose or common table sugar) and is available as syrup or dried and is commonly used as coloring in baking and beverages such as cola drinks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 2, 4, 6, 8, 10, 12, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites "wherein the sucrose is granulated sugar or crystal sugar." This is unclear since the claim from which this claim depends requires the sugar sucrose be in solution and thus cannot be granulated or crystal.

35 USC § 102 and 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Swaine et al. (US 3632354).

The present claims are broadly discussed hereinabove in the section ***Claims Analysis*** which is incorporated by reference.

See claim 3 and column 1, lines 67-70. Once the sugar is dissolved, the limitation of Applicant's claim 2 is without probative value. Further, crystals are suggested at column 2, lines 65-75.

The discovery of new use or property of an otherwise old material generally does not lend patentability to said material.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swaine et al. (US 3632354) as applied to claims 1 and 2 above, and further in view of official notice.

The present claims are broadly discussed hereinabove in the section ***Claims Analysis*** which is incorporated by reference.

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Potassium sorbate is well known and used additive for foods as a preservative and thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed it as such in the compositions of '354.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Zirlin (US 3832475).

The present claims are broadly discussed hereinabove in the section ***Claims Analysis*** which is incorporated by reference.

See example 1. Once the sugar is dissolved, the limitation of Applicant's claim 2 is without probative value.

The discovery of new use or property of an otherwise old material generally does not lend patentability to said material.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zirlin (US 3832475) as applied to claims 1 and 2 above, and further in view of official notice.

The present claims are broadly discussed hereinabove in the section ***Claims Analysis*** which is incorporated by reference.

Potassium sorbate is well known and used additive for foods as a preservative and thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed it as such in the compositions of '475.

Allowable Subject Matter

Claims 3, 7, 9, 11, 13, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4, 8, 10, 12, 14, and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 571-272-1125. The examiner can normally be reached on Tuesday-Friday, 9:30 to 7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S. Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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